



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,084	11/07/2001	Shuji Nakao	57454-248	4719

7590 09/29/2003  
McDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

YOUNG, CHRISTOPHER G

ART UNIT	PAPER NUMBER
----------	--------------

1756

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/986,084

Applicant(s)

NAKAO ET AL.

Examiner

Christopher G. Young

Art Unit

1756

-- Th MAILING DATE of this communication appears on the cov r she t with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

2. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan 6-120116.

The focus monitoring apparatus used for pattern formation of a semiconductor device as claimed is still clearly described, shown and suggested by the Japanese document submitted by Applicants. See the Figures and Abstract.

#### ***Claim Rejections - 35 USC § 103***

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 6-120116 in view of King et al.

The broad scope of the protection sought is described, taught and suggested by the Japanese document as discussed in paragraph 4 of the previous Office Action (P.N. 5). All comments presented in the previous rejection are incorporated by reference herein, and the rejection is repeated.

#### ***Response to Argument***

4. The Examiner has carefully considered all comments presented by Applicants in their response to the Office Action. The rejections of record have been repeated, and maintained, as set forth in Paper Number 5. Applicants have argued that both rejections must fail because the Examiner has not provided an English language translation of the Japanese document. Additionally, that the Examiner has not pointed to the specific passages of the reference for presenting support of the rejections of record relying on the Japanese document.

Art Unit: 1756

Applicants refer to a Board decision saying that a translation should be provided, where needed. In this instance, a translation is not needed. Initially, the Examiner points out that the reference in question was submitted by the Applicants as being pertinent in the instant application. It is Applicants responsibility to state the pertinence of any references submitted for consideration. See MPEP 609 A (3). Since the translation submitted was simply the Abstract, it is up to Applicants to provide a substantive translation rebutting the Examiners position if the teachings of the reference are not adequately represented by the submitted Abstract translation. Secondly, the Examiner notes that the Applicants are Japanese. It is not seen how Japanese applicants, that submitted the document in question, cannot properly interpret the reference. It is alleged by Applicants that a translation needs to be provided so that Applicants can objectively evaluate the complete disclosure. It is the Examiners position that Applicants evaluated the complete disclosure prior to their submission of the document for prosecution in the application.

In view of this, the arguments are not found to be persuasive in overcoming the rejections of record.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

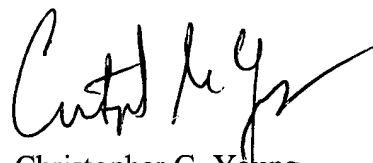
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher G. Young whose telephone number is 703-308-2984. The examiner can normally be reached on Monday-Friday.

Art Unit: 1756

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Chris G. Young", with a stylized flourish at the end.

Christopher G. Young  
Primary Examiner  
Art Unit 1756

cgy